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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,678	05/04/2006	Kazuki Noda	59018US007	4637
32692 7590 06/24/2009 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER HENRY, CALEB E				
ART UNIT 2894		PAPER NUMBER		
NOTIFICATION DATE 06/24/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com
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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 05/26/2009 have been fully considered but they are not persuasive:

Concerning claim 1, "...Oka teaches that the hardening of the surface protecting layer is done after grinding. Or, taken as a whole, Oka teaches adhering the surface protecting layer to the wafer, grinding the wafer, and hardening the wafer to lower its adhesiveness. In contrast, Applicant's claim 1 requires joining (adhering) a wafer to a fluid surface protecting layer, hardening the layer and then grinding the wafer. The grinding is done after hardening the surface protecting layer. Thus, the Examiner has not shown that Oka teaches all of the elements of the invention." [Applicants arguments, pages 6-7]

- One with common knowledge in the art would know that when the UV curing resin is layered onto the IC it is "hardened" in order to protect the IC. When the resin is to be removed, it is "hardened" even further, causing it to become brittle and removable. Thus, there are two hardening stages, the latter being the extreme. Since Oka uses UV curing resin, it would have been obvious for him to utilize this method. Thus, Oka's teachings do read on the limitation of claim 1 which states that the resin must be hardened before grinding takes place.

Concerning claim 2, "With regards to claim 2 and as argued above, the Examiner has not shown that Oka teaches or suggests that the grinding of the wafer is done after

hardening said surface protecting layer as required by Applicant's claim 2." [Applicants arguments, page 7]

- Examiner refers to previously presented argument.

Concerning claim 3, "The Examiner has not shown where Morita teaches or suggests a surface protecting layer that is solid at room temperature, becomes fluid upon heating and hardens upon exposure to radiation or upon heating to a temperature higher than the fluidization temperature." [Applicants arguments, pages 7-8]

- Examiner points to Morita, col. 3, lines 55-57 which states that the component of the resin can be liquid or solid at room temperature. Also, Morita mentions the various components of the resin. The components would allow the resin to become fluid upon heating and harden due to radiation or heat (col. 3, lines 38-67). Thus, the teachings of Morita due read on the limitations of claim 3.

Concerning claims 4-12, these independent claims are rejected based on their dependence.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CALEB HENRY whose telephone number is (571)270-5370. The examiner can normally be reached on Monday-Thursday, 7:30 AM- 5:30 PM, ALT. Fridays, Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly D. Nguyen can be reached on 571-272-2402. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CALEB HENRY/
Examiner, Art Unit 2894

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/595,678

Applicant(s)

NODA, KAZUKI

Examiner

CALEB HENRY

Art Unit

2894

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-12.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Claims have not been amended. Also, see Detailed Action attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: IDS filed 04/22/2009 is considered (attached).

06/21/2009

/THANH V. PHAM/
Primary Examiner, Art Unit 2894